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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,389	03/26/2001	Jay Walker	01-003	9646

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EXAMINER

CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/817,389		WALKER ET AL.	
	Examiner		Art Unit	
	Paul Callahan		2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>09072004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-54 are pending in this application and have been examined.

Information Disclosure Statement

2. The information disclosure statement filed 3-26-01 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Only the US Patent documents are found in the file. If the Applicant wishes the missing foreign Patent documents and non-Patent literature to be considered it should be resubmitted.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 7-9, 12, 15-18, 36-39, and 41-50, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schull US 5,509,070.

As for claim 1, Schull teaches a method comprising: connecting to a user via a second connection (col. 5 lines 1-20); and providing the user access to data provided by

a server, in which access is via a first connection between the user and the server (col. 5 lines 1-20, col. 6 lines 20-25, col. 10 lines 50-57).

As for claims 36, 39, and 43, Schull teaches connecting to a server via a first connection, in which the server provides access to data (col. 5 lines 1-20, col. 6 lines 20-25, col. 10 lines 50-57), and connecting to an access controller via a second connection (fig. 1 items 80, 93), and accessing data via the first connection after connecting to the access controller (fig. 1 items 80, 93, 100).

As for claims 2 and 37, Schull teaches a second connection that is a telephone connection (col. 1 lines 15-35, col. 5 lines 1-20).

As for claims 3 and 38, Schull teaches a second connection that is a shared-revenue telephone number (col. 10 lines 25-49).

As for claim 4, Schull teaches providing the user access after connecting to the user (col. 10 lines 25-49).

As for claim 5, Schull teaches providing the user access in response to connecting to the user (col. 11 lines 15-25).

As for claim 7, Schull teaches providing the user access comprising transmitting a signal (col. 10 lines 25-49, col. 11 lines 8-12).

As for claims 8 and 41, Schull teaches providing the user access where said access comprises access to a server (col. 5 lines 1-20, col. 6 lines 20-25, col. 10 lines 50-57).

As for claims 12, 15, and 18, Schull teaches charging the user for providing access (col. 1 lines 14-19) based on a fee.

As for claims 16, 17, and 46-50, Schull teaches a second connection that is a billing system that is a shared revenue telephone system and in which an access controller charges for access to the data (col. 11 lines 14-34).

As for claims 9 and 42, Schull teaches access to data comprising enabling the user to receive the data and receiving the data (fig. 1 items 15, 20).

As for claim 44, Schull teaches an access controller that instructs a server to provide access (fig. 1 items 60, 80, 85, 90, 93, and 100).

As for claim 45, Schull teaches receiving access to the data from an access controller (col. 5 line 58 through col. 6 line 12).

5. Claim 51 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ananda US 5,548,645. Ananda teaches a method, comprising accessing data provided by a server via a first communication channel only so long as a connection to an access controller is open (col. 2 lines 50-65, col. 13 line 43 through col. 14 line 19).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 6, 10, 11, 19, 20-28, 30-35, 40, 53, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schull, and Ananda.

As for claims 6, 19, 53, and 54, Schull teaches a method, comprising user access to data provided by a server via a first communication channel (5 lines 1-20, col. 6 lines 20-25, col. 10 lines 50-57), where the user is in communication with a billing center via a second channel (col. 10 lines 25-49). Schull does not teach providing access to the user only so long as the user is connected to a billing center via the second communication channel. Ananda however does teach provision of user access to data only so long as connection to a billing center is maintained (col. 13 line 43 through col. 14 line 19). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature of Ananda into the system of Schull. It would have been desirable to do so as this would allow for more provider control of user access to data. The motive for making this combination may be found, for example, in Schull col. 2 where the advantage of instantly rewarding users (via access) who pay for access to software.

As for claims 10, 20, 21, 22, and 52, Schull teaches determining if a user is in communication with a shared revenue telephone number via a second connection between the user and a shared revenue telephone number (col. 11 lines 14-34). Schull teaches user access to data via a first connection (~~col. 5 lines 1-20, col. 6 lines 20-25, col. 10 lines 50-57~~). However Schull does not teach providing access to the user only so long as the user is connected to a billing center via the second communication channel. Ananda however does teach provision of user access to data only so long as

Art Unit: 2137

connection to a billing center is maintained (col. 13 line 43 through col. 14 line 19).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature of Ananda into the system of Schull. It would have been desirable to do so as this would allow for more provider control of user access to data. The motive for making this combination may be found, for example, in Schull col. 2 where the advantage of instantly rewarding users (via access) who pay for access to software.

As for claims 11, 23, 26, 27, 28, 30, 31 and 34. Schull teaches all of the common limitations of claim 20 and 23, 26, 27, 28, 30, 31 and 34, as detailed supra. Claims 23, 26, 27, 28, 30, 31 and 34 differ from claim 20 only in the limitations of an indicator of the termination of a second connection being given, denying user access after such an indication, and where denial of access comprises denying the user access to the data server. Schull fails to teach this feature. However Ananda does teach these features (fig. 9 item 920). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature of Ananda into the system of Schull. It would have been desirable to do so as this would allow for more provider control of user access to data. The motive for making this combination may be found, for example, in Schull col. 2 where the advantage of instantly rewarding users (via access) who pay for access to software.

As for claims 24, 25, 32, and 33, Schull teaches a second connection that is a telephone connection that is a shared revenue telephone number, and where the connection is to a shared revenue billing system (col. 11 lines 14-34).

As for claims 29 and 35, Schull teaches connecting to a user via a telephone connection that is a shared revenue billing system (col. 11 lines 14-34), and transmitting a first signal to a server that instructs the server to provide access to the user to data provided by the server (col. 5 lines 1-20, col. 6 lines 20-25, col. 10 lines 50-57) in which access is provided via a first connection between the user and the server. However Schull does not teach determining if the second telephone connection is terminated, and transmitting a second signal to the server in which the second signal instructs the server to deny access to the data by the user. Ananda however does teach provision of user access to data only so long as connection to a billing center is maintained and transmission of such a signal (col. 13 line 43 through col. 14 line 19, fig. 9 items 922, 924). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature of Ananda into the system of Schull. It would have been desirable to do so as this would allow for more provider control of user access to data. The motive for making this combination may be found, for example, in Schull col. 2 where the advantage of instantly rewarding users (via access) who pay for access to software.

As for claim 40, Schull does not teach providing access to the user only so long as the user is connected to an access controller via the second communication channel. Ananda however does teach provision of user access to data only so long as connection to an access controller is maintained (col. 13 line 43 through col. 14 line 19). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature of Ananda into the system of Schull. It would have

been desirable to do so as this would allow for more provider control of user access to data. The motive for making this combination may be found, for example, in Schull col. 2 where the advantage of instantly rewarding users (via access) who pay for access to software.

8. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schull and Official Notice taken as detailed infra.

The claims contain the limitations of Claim 12 and the additional limitations of charging users where the charging comprises charging a user based on a time of a first connection or a second connection. The Examiner has interpreted this to mean, "...based upon a time duration of a first connection or a second connection. Schull teaches all of the limitations of claim 12 upon which claim 13 and 14 are based, but does not teach the limitations of claims 13 and 14. However Official Notice may be taken that the step of charging a user for access to data or for charging for use of data based upon time duration of access or time duration of use is old and well known in the art. CATV systems commonly use such billing techniques in "pay per view" media delivery systems. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the system of Schull. It would be desirable to do so as this would allow for more provider control of user access to data. The motive for making this combination may be found, for example, in Schull col. 2 where the advantage of instantly rewarding users (via access) who pay for access to software.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-1336. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Caldwell, can be reached on (703) 306-3036. The fax phone number for the organization where this application or proceeding is assigned is: (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

9/7/04

Paul Callahan